

ESTTA Tracking number: **ESTTA668014**

Filing date: **04/21/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91209470
Party	Defendant Apple Inc.
Correspondence Address	KIMBERLY A ECKHART APPLE INC 1 INFINITE LOOP, #MS3TM CUPERTINO, CA 95014 2083 UNITED STATES trademarkdocket@apple.com, keckhart@apple.com, vtom@apple.com
Submission	Response to Board Order/Inquiry
Filer's Name	Dale M. Cendali
Filer's e-mail	dale.cendali@kirkland.com, claudia.ray@kirkland.com, bonnie.jarrett@kirkland.com
Signature	/Dale M. Cendali/
Date	04/21/2015
Attachments	FINAL Notice of Final Disposition (2).pdf(175712 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK
OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL
BOARD**

In the Matter of Application Serial No. 85/008,412
Published in the Official Gazette on December 18, 2012
Mark: IBOOKS

J.T. COLBY & COMPANY, INC.,

Opposer,

Opposition No. 91209470

-against-

APPLE INC.,

Applicant

**NOTICE OF FINAL DISPOSITION OF RELATED
CIVIL ACTION AND REQUEST FOR JUDGMENT**

Pursuant to TBMP § 510.02(b), Applicant Apple Inc. (“Apple” or “Applicant”) hereby notifies the Trademark Trial and Appeal Board (the “T.T.A.B.” or “Board”) that there has been a final determination in favor of Apple in *J.T. Colby & Co. v. Apple Inc.*, Civil Action No. 11-CIV-4060 (DLC) (“Civil Action”). As the federal court, whose determination is binding on the Board, has conclusively determined that there is no likelihood of confusion between the parties’ marks, Apple respectfully requests that the Board dismiss Colby’s Opposition with prejudice and permit Apple’s mark “iBooks” to proceed to registration.

This Opposition was suspended on March 29, 2013, pending a final determination in the Civil Action. On September 29, 2014, the Second Circuit upheld the district court’s finding that there is no likelihood of confusion between Apple’s “iBooks” mark for an e-reader software program and J.T. Colby and Co., Inc.’s (“Colby” or “Opposer”) alleged “ibooks” mark used on

physical books and e-books. That Order has now become final, as Colby did not file a petition for certiorari with the Supreme Court within 90 days from the entry of judgment,¹ as required by United States Supreme Court Rule 13.1. The Second Circuit's decision is attached as Exhibit A.

As Opposer acknowledged in its Motion to Suspend Proceedings, the federal court's determination—including on the issue of likelihood of confusion—is binding on the T.T.A.B. through the doctrines of *res judicata* and collateral estoppel. See *Stephen Slesinger, Inc. v. Disney Enters., Inc.*, Opposition No. 91179064, 2011 WL 2489755, at *4 (June 8, 2011) (dismissing opposition and cancellation actions where determination in prior civil action precluded plaintiff from prevailing on its claims regarding likelihood of confusion, dilution, fraud, or ownership); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 U.S.P.Q. 805, 807 (T.T.A.B. 1971) (“[A] decision by the United States District Court would be binding on the Patent Office...”); *Midland Co-ops., Inc. v. Midland Int'l Corp.*, 421 F.2d 754, 758 (C.C.P.A. 1970) (applying doctrine of *res judicata* and sustaining T.T.A.B.'s dismissal of opposition where applicant prevailed in federal court on issue of likelihood of confusion); McCarthy on Trademarks and Unfair Competition § 32:94 (4th ed. 2012) (noting that a federal court's decision regarding likelihood of confusion under the Lanham Act § 2(d) is binding on the Patent and Trademark Office); Opposer's Br. at 3, *J.T. Colby, Inc. v. Apple Inc.*, Opposition No. 91209470 (Feb. 26, 2013).

Where an opposition is based on likelihood of confusion, and the federal court finds that there is no likelihood of confusion between the parties' marks, the T.T.A.B. should dismiss the opposition. See *Midland Co-ops.*, 421 F.2d at 756. This is true regardless of whether the court opined directly on the issue of the applicant's right to register its mark. See *id.* (“While the question of applicant's right to register ‘MIDLAND’ in the United States Patent Office was not

¹ Colby petitioned for rehearing at the Second Circuit on October 14, 2014, which petition was denied on December 2, 2014.

before the court in the civil action and no ruling thereon was therefore made by it, . . . [the court] held that the simultaneous use by the parties of the mark on the specified goods would not be likely to cause confusion in trade. In view thereof, it is concluded that opposer is estopped from asserting in this proceeding that it would be damaged by reason of applicant's registration of the mark 'MIDLAND' on the goods specified in its application.”).

Here, the Opposition is premised on an alleged likelihood of confusion between the parties' respective marks. *See* Notice of Opposition at ¶¶ 12–13, *J.T. Colby, Inc. v. Apple Inc.*, Opposition No. 91209470 (Feb. 14, 2013) (alleging that Apple's application should be refused under Section 2(a) of the Lanham Act, as likely to falsely suggest a connection with Colby's mark, or under Section 2(d) as likely to cause confusion with its mark). The Second Circuit explicitly rejected Colby's likelihood of confusion claim, however, holding that “the district court correctly decided that these factors do not even raise a genuine issue of material fact as to whether there is any *likelihood* that an appreciable number of ordinarily prudent purchasers are likely to be misled as to the source of the goods in question.” *J.T. Colby & Co. v. Apple Inc.*, 586 F. App'x 8, 10 (2d Cir. 2014) (internal quotation marks and citation omitted) (emphasis in original) (affirming district court's grant of summary judgment to Apple). This finding warrants dismissal of Opposer's claims under Lanham Act §§ 2(a) and 2(d). *See Elec. Realty Assocs., Inc. v. Extra Risk Assocs., Inc.*, 217 U.S.P.Q. 810, at *6 (U.S.P.Q. 1982) (dismissing opposition and noting, “[h]aving already decided that opposer has not established its claim [for likelihood of confusion] under Section 2(d), opposer cannot possibly prevail based on Section 2(a) irrespective of whether the further requirements of a claim of deceptiveness have been met”).

Therefore, pursuant to the Second Circuit's final determination in *J.T. Colby & Co. v. Apple Inc.*, Civil Action No. 11-CIV-4060 (DLC), Apple respectfully requests that the Board

dismiss this Opposition and permit Apple's application for its "iBooks" mark, Serial No.

85/008412, to proceed to registration.

Dated: April 21, 2015

Respectfully Submitted,

APPLE INC.

Dale Cendali
Dale Cendali
Claudia Ray
Bonnie Jarrett
Kirkland & Ellis LLP
601 Lexington Ave.
New York, NY 10022
Telephone: (212) 446-4800
dale.cendali@kirkland.com
claudia.ray@kirkland.com
bonnie.jarrett@kirkland.com

EXHIBIT A

586 Fed.Appx. 8

This case was not selected for
publication in West's Federal Reporter.

RULINGS BY SUMMARY ORDER DO NOT HAVE
PRECEDENTIAL EFFECT. CITATION TO A
SUMMARY ORDER FILED ON OR AFTER JANUARY
1, 2007, IS PERMITTED AND IS GOVERNED BY
FEDERAL RULE OF APPELLATE PROCEDURE
32.1 AND THIS COURT'S LOCAL RULE 32.1.1.

WHEN CITING A SUMMARY ORDER IN A
DOCUMENT FILED WITH THIS COURT, A PARTY
MUST CITE EITHER THE FEDERAL APPENDIX
OR AN ELECTRONIC DATABASE (WITH THE
NOTATION "SUMMARY ORDER"). A PARTY CITING
A SUMMARY ORDER MUST SERVE A COPY OF IT
ON ANY PARTY NOT REPRESENTED BY COUNSEL.

United States Court of Appeals,
Second Circuit.

J.T. COLBY & COMPANY, INC., DBA Brick
Tower Press, J. Boylston & Company, Publishers
LLC, iPicturebooks LLC, Plaintiffs–Appellants,

v.

APPLE INC., AKA Apple, Inc., Defendant–Appellee.

No. 13–2227–cv. | Sept. 29, 2014.

Synopsis

Background: Book publishers brought trademark infringement action against computer manufacturer, alleging infringement of their “ibooks” mark. The United States District Court for the Southern District of New York, Denise Cote, J., 2013 WL 1903883, entered summary judgment in favor of the manufacturer, and publishers appealed.

Holding: The Court of Appeals held that manufacturer's “iBooks” mark for an e-reader software program that appeared on its hardware devices to identify a virtual marketplace for buying e-books did not create likelihood of reverse confusion with publishers' prior “ibooks” imprint used on physical books and e-books.

Affirmed.

West Headnotes (3)

[1] Trademarks

➤ “Reverse” confusion

Computer manufacturer's “iBooks” mark for an e-reader software program that appeared on its hardware devices to identify a virtual marketplace for buying e-books did not create likelihood of reverse confusion with book publishers' prior “ibooks” imprint used on physical books and e-books; manufacturer's “iBooks” mark was, along with its suite of other “i”-prefix marks, part of a well-known international brand, while the “ibooks” imprint was neither similar to the manufacturer's mark in appearance nor proximate to it in the marketplace. Lanham Act, § 43(a)(1)(A), 15 U.S.C.A. § 1125(a)(1)(A).

Cases that cite this headnote

[2] Trademarks

➤ Alphabetical listing

iBooks.

Cases that cite this headnote

[3] Trademarks

➤ Alphabetical listing

ibooks.

Cases that cite this headnote

***8 UPON DUE CONSIDERATION, IT IS HEREBY ORDERED, ADJUDGED, AND DECREED** that the order of the District Court is **AFFIRMED**.

Attorneys and Law Firms

Robert L. Raskopf (Todd Anten, on the brief), Quinn Emanuel Urquhart & Sullivan, LLP, New York, NY, Partha P. Chattoraj, David A. Shaiman, Allegaert Berger & Vogel LLP, New York, NY, for Plaintiffs–Appellants.

Richard P. Bress, Latham & Watkins LLP, Washington, DC,
Perry J. Viscounty, Latham & Watkins LLP, Menlo Park,
CA, Jennifer L. Barry, Latham & Watkins LLP, San Diego,
CA, Matthew W. Walch, Latham & Watkins LLP, Chicago,
IL, Dalue M. Cendali (Claudia Ray, Bonnie L. Jarrett, on
the brief), Kirkland & Ellis *9 LLP, New York, NY, for
Defendant–Appellee.

PRESENT: DEBRA ANN LIVINGSTON, GERARD E.
LYNCH, and CHRISTOPHER F. DRONEY, Circuit Judges.

SUMMARY ORDER

Plaintiffs–Appellants J.T. Colby & Company, Inc.; J. Boylston & Company, Publishers LLC; and iPicturebook LLC (“Plaintiffs”) are three independent book publishers owned by John Colby (“Colby”). These companies have been publishing physical books and e-books under the imprint “ibooks” since 2006, when they purchased the rights to use the imprint in a bankruptcy proceeding. Defendant–Appellee Apple Inc. (“Defendant”) is a major technology corporation that uses the trademark “iBooks” for an e-reader software program that appears on its hardware devices. On June 15, 2011, Plaintiffs filed suit in the United States District Court for the Southern District of New York claiming, *inter alia*, that Defendant's use of “iBooks” infringed on Plaintiffs' trademark rights in violation of section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(A). After discovery, the parties filed cross-motions for summary judgment. The district court (Cote, J.) granted summary judgment for Defendant and dismissed, *inter alia*, Plaintiffs' trademark infringement claim. *J.T. Colby & Co. v. Apple Inc.*, No. 11–cv–4060, 2013 WL 1903883 (S.D.N.Y. May 8, 2013). This appeal followed. We assume the parties' familiarity with the underlying facts, the procedural history of the case, and the issues on appeal.

We review the district court's grant of summary judgment *de novo*. *Mullins v. City of N.Y.*, 653 F.3d 104, 113 (2d Cir.2011). “In moving for summary judgment against a party who will bear the ultimate burden of proof at trial, the movant may ... point[] to an absence of evidence to support an essential element of the nonmoving party's claim.” *Gummo v. Village of Depew*, 75 F.3d 98, 107 (2d Cir.1996). We “constru[e] the evidence in the light most favorable to the non-moving party,” and uphold the grant of a motion for summary judgment if we conclude that “there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” *Silverman v. Teamsters Local 210 Affiliated Health & Ins.*

Fund, 761 F.3d 277, 284 (2d Cir.2014) (quoting Fed.R.Civ.P. 56(a)).

Section 43(a) of the Lanham Act prohibits the use in commerce of “any word, term, name, symbol, or device” that “is likely to cause confusion ... as to the origin, sponsorship or approval” of goods or services. 15 U.S.C. § 1125(a) (1). The provision protects both registered and unregistered trademarks. *Thompson Med. Co. v. Pfizer Inc.*, 753 F.2d 208, 212 (2d Cir.1985). To prevail on an infringement claim, a plaintiff must prove (1) that it owns a “protectable trademark” and (2) that the defendant's mark “is likely to confuse consumers as to the source or sponsorship of [the plaintiff's] product.” *Nabisco, Inc. v. Warner–Lambert Co.*, 220 F.3d 43, 45 (2d Cir.2000).

In this case, the confusion that Plaintiffs allege is that consumers may believe the Plaintiffs are “unauthorized infringer[s]” of Apple's trademark, *Kelly–Brown v. Winfrey*, 717 F.3d 295, 304–05 (2d Cir.2013), or that their books are “produced by” Apple, *Lang v. Ret. Living Publ'g Co.*, 949 F.2d 576, 583 (2d Cir.1991). The Lanham Act guards against this “reverse confusion” to prevent “a larger, more powerful company [from] usurping the business identity of a smaller senior [trademark] user.” *10 *Commerce Nat'l Ins. Servs., Inc. v. Commerce Ins. Agency, Inc.*, 214 F.3d 432, 445 (3d Cir.2000). To assess the likelihood of confusion, we apply the eight-factor test from *Polaroid Corp. v. Polarad Electronics Corp.*, 287 F.2d 492 (2d Cir.1961). These eight factors are: “(1) the strength of the mark, (2) the similarity of the two marks, (3) the proximity of the products, (4) actual confusion, (5) the likelihood of plaintiff[s] bridging the gap, (6) defendant's good faith in adopting its mark, (7) the quality of defendant's products, and (8) sophistication of the consumers.” *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 454 F.3d 108, 116 (2d Cir.2006). This evaluation is not a “mechanical process”; instead, we focus on the “ultimate question of whether consumers are likely to be confused.” *Nabisco*, 220 F.3d at 46 (citations omitted).

Plaintiffs have not raised more than a “mere possibility” that consumers are likely to be confused by Defendant's trademark. *Nora Beverages, Inc. v. Perrier Grp. of Am., Inc.*, 269 F.3d 114, 121 (2d Cir.2001). Apple's “iBooks” mark is, along with its suite of other “i”-prefix marks, part of a well-known international brand. But Plaintiffs' “ibooks” imprint, when viewed in context, is neither similar to Defendant's mark in appearance nor proximate to it in the marketplace. Plaintiffs' imprint appears on physical

books and e-books. It is frequently surrounded by contextual information that associates it with a publishing company, including the publishing company's name and location, the title of a book and its author, and other copyright information. *See Star Indus., Inc. v. Bacardi & Co.*, 412 F.3d 373, 386 (2d Cir.2005) (“[I]n assessing similarity, courts look to the overall impression created by the logos and the context in which they are found....”). Defendant's mark, on the other hand, identifies a virtual marketplace for buying e-books and appears exclusively on Apple-branded hardware. *See id.*; *Lang*, 949 F.2d at 581–82 (finding trademarks dissimilar because “the general impression conveyed to the public by the[] designations differs significantly”). The Defendant does not publish books and the Plaintiffs do not create a marketplace to purchase them; their products do not directly compete, serve a similar purpose, or appear in the same channels of commerce. *See Lang*, 949 F.2d at 582.¹ Plaintiffs' argument that they will bridge that gap is no more than speculation. *See Lane Capital Mgmt., Inc. v. Lane Capital Mgmt., Inc.*, 192 F.3d 337, 346 (2d Cir.1999). In light of these significant differences, we reject Plaintiffs' contention that a reasonable jury could conclude, as a matter of “common sense,” that consumers are actually confused by the two marks. Indeed, the district court correctly decided that these factors do not even raise a genuine issue of material fact as to “whether there is any *likelihood* that an appreciable number of ordinarily prudent purchasers are likely to be misled ... as to the source of the goods in question.” *Mushroom Makers, Inc. v. R.G. Barry Corp.*, 580 F.2d 44, 47 (2d Cir.1978) (emphasis added).

***11** The circumstances surrounding Defendant's decision to adopt the “iBooks” trademark also do not plausibly support a likelihood of consumer confusion. A defendant's bad faith or intentional copying can “bolster[] a finding of consumer

confusion.” *Charles of the Ritz Grp. Ltd. v. Quality King Distribs., Inc.*, 832 F.2d 1317, 1322 (2d Cir.1987). But here, Plaintiffs have failed to raise a genuine dispute of material fact about Defendant's bad faith. Apple conducted an extensive trademark clearance process that did not reveal Plaintiffs' use of the “iBooks” imprint. *See Star Indus.*, 412 F.3d at 388 (“This Court has never held adoption of a mark with no knowledge of a prior similar mark to be in bad faith even in the total absence of a trademark search....”). While Colby informed Defendant that his companies used the “iBooks” imprint, he did so only after Apple had publicly announced its “iBooks” e-reader program. That tardy knowledge does not evince an intent to “capitaliz[e] on [Plaintiffs'] reputation” or “promote confusion” between the marks. *W.W.W. Pharm. Co. v. Gillette Co.*, 984 F.2d 567, 575 (2d Cir.1993), *abrogated on other grounds by Deere & Co. v. MTD Prods., Inc.*, 41 F.3d 39, 46 & n. 10 (2d Cir.1994); *see also Lang*, 949 F.2d at 584 (“[A]doption of a trademark with actual knowledge of another's prior registration of a very similar mark may be consistent with good faith.”).

We have reviewed Plaintiffs' remaining arguments in support of a likelihood of confusion and find them to be without merit. Since Plaintiffs have failed to raise a genuine dispute of material fact about the likelihood that consumers will be confused by Defendant's use of the “iBooks” mark, we need not and do not address whether their “iBooks” imprint is a protectable trademark under the Lanham Act. The judgment of the district court is **AFFIRMED**.

Parallel Citations

42 Media L. Rep. 2388

Footnotes

- ¹ Although we have previously held that products are proximate when they are “complementary,” *see Plus Prods. v. Plus Discount Foods, Inc.*, 722 F.2d 999, 1008 (2d Cir.1983) (holding that a food store's offering of vitamins was proximate to a nutritional company's vitamin product); *Am. Int'l Grp., Inc. v. London Am. Int'l Corp.*, 664 F.2d 348, 352–53 (2d Cir.1981) (holding that a junior user's service of “arrang[ing] insurance for its customers” was complementary with a senior user's insurance product), here only a very small fraction of Plaintiffs' products—1.83%—are complementary. The vast majority of Plaintiffs' products are physical books that cannot be sold through Defendant's product. Such a small fraction of products is unlikely to induce the consuming public to associate Plaintiffs' and Defendant's products sufficient to sow confusion.

CERTIFICATE OF SERVICE

I hereby certify that on April 21, 2015, I caused copies of the foregoing **NOTICE OF FINAL DISPOSITION OF RELATED CIVIL ACTION AND REQUEST FOR JUDGMENT** to be served via Federal Express and e-mail upon the following individuals:

Claudia T. Boganos
Quinn Emanuel Urquhart & Sullivan LLP
51 Madison Ave., 22nd Floor
New York, NY 10010
claudiabogdanos@quinnemanuel.com
ulanaholubec@quinnemanuel.com
Phone: (212) 849-7000

Dated: April 21, 2015



Felicity Kohn